

Remarks

Applicant acknowledges receipt of the *Final Office Action* dated April 18, 2007 and the *Advisory Action* dated July 6, 2007 wherein the Patent Office maintained the rejection of claims 17-20, 23-26, 28-36 and 38-42 under 35 U.S.C. § 103(a). In response, Applicant respectfully requests entry of the claim amendments submitted herein and reconsideration of the presently claimed application in view of the following remarks.

Status of Claims

Claims 18, 19, 23-26, 28, 33-36 and 38 were previously presented.

Claims 1-16, 21, 22, 27 and 37 were previously canceled.

Claims 17, 30, 31 and 39-42 are currently amended.

Claims 20, 29 and 32 are currently canceled.

Therefore, claims 17-19, 23-26, 28, 30, 31, 33-36 and 38-42 are currently pending in the application.

Substance of Telephone Conference

On July 11, 2007, Patent Examiner Eric Gates granted a telephone conference to Applicant's representative Shannon W. Bates to discuss the *Final Office Action* dated April 18, 2007 and the *Advisory Action* dated July 6, 2007, and in particular, the rejection of the independent claims 17, 31 and 42 claims under 35 U.S.C. § 103(a).

Applicant's representative and the Examiner discussed the distinctions between the Applicant's invention and the cited references, and Applicant's representative proposed that clarifying amendments to independent claims 17, 31 and 42 would be sufficient to overcome the 35 U.S.C. § 103(a) rejections. The Examiner suggested clarifying independent claims 17 and 42

by reciting that the reader and the pre-reader share an actual experience that corresponds to the planned shared experience related to the theme of the repetitive language kit, and amending claim 31 to recite a planned shared experience and corresponding actual shared experience between the reader and the pre-reader. The Examiner further suggested combining claim 20 into claim 17 and claim 32 into claim 31 to add the step of reading the plurality of pages to the pre-reader. The Examiner indicated that these claim amendments would be sufficient to overcome the 35 U.S.C. § 103(a) claim rejections issued in the *Final Office Action*, but a further search would be conducted and a RCE would be necessary.

Accordingly, Applicant amends the independent claims 17, 31 and 42 as suggested by the Examiner; cancels dependent claims 20, 29 and 32; and amends dependent claims 30 and 39-41 for consistency with the independent claims in the present *Amendment and Response to Final Office Action dated May 8, 2007 and Advisory Action dated July 6, 2007*, which is being filed concurrently with a *Request for Continued Examination* (RCE).

Claim Rejections – 35 USC § 103(a)

In the *Final Office Action*, the Patent Office maintained the rejection of claims 17-20, 23-26, 31-36 and 40-42 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,844,797 to *Johnson* in view of U.S. Patent No. 5,957,693 to *Panec*. The Patent Office also maintained the rejection of claims 28-30, 38 and 39 under 35 U.S.C. § 103(a) as being unpatentable over *Johnson* in view of *Panec* and further in view of U.S. Patent No. 5,651,678 to *Phillips*. In response, Applicant respectfully submits that the combination of *Johnson* with the other cited references does not establish a *prima facie* case of obviousness as to any of the pending claims 17-19, 23-

26, 28, 30, 31, 33-36 and 38-42, as amended herein. According to MPEP § 2142, three basic criteria must be met to establish a *prima facie* case of obviousness:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Applicant submits that no *prima facie* case of obviousness has been established at least because the prior art references fail to teach or suggest all of the claimed limitations.

Johnson is directed to a photograph album for a selected theme comprising pre-printed pictures or views and accompanying text "to provide the user with guidance and inspiration to take a corresponding series of photographs on the same theme" (Abstract). The user's photographs are substituted for the pre-printed pictures or views to provide "a structured album of photographs and appropriate accompanying text" (Abstract). In one embodiment, the photograph album is in the form of a guidebook appropriate to a geographic location, historic building or the like, with spaces to receive photographs taken by the user. The stated purpose is to "provide a personalized yet organized record of the visit" while providing "additional interest for third parties viewing the album in the way that a disorganized collection of individual photographs will not" (col. 1, lines 13-26). Thus, *Johnson* is directed only to a method of creating structured, organized and personalized photograph albums for a selected theme.

With respect to the secondary references, *Panec* is directed to a method for promoting reading in a novice reader using a book that includes a story with two texts, one written at a reading level appropriate for a skilled reader and the other written at a lower reading level appropriate for

the novice reader. Thus, the method disclosed by *Panec* promotes reading by using a traditional, pre-assembled, non-personalized book.

Phillips teaches an educational aid and a method for using the system to teach students to read using sight-word vocabularies. The method relies on the student's natural ability to recall information, such as simple songs, rhymes, and stories which are easily memorized (col. 5, lines 53-55). Thus, the method disclosed by *Phillips* promotes sight-word reading based on memorization.

Applicant respectfully submits that the combination of *Johnson* with *Panec* and/or *Phillips* fails to establish a *prima facie* case of obviousness as to any of the pending claims 17-19, 23-26, 28, 30, 31, 33-36 and 38-42, as amended herein, at least because none of the prior art references, either alone or in combination, teaches or fairly suggests all of the claimed limitations. In particular, with respect to independent claims 17, 31 and 42, the cited references fail to teach or fairly suggest a process comprising: obtaining a repetitive language kit having a theme related to a planned shared experience between a reader and a pre-reader, the reader sharing an actual experience with the pre-reader corresponding to the planned shared experience, memorializing the actual shared experience between the reader and the pre-reader through one or more pictorial representations, constructing a personalized repetitive language book including said pictorial representations, and the reader reading a plurality of pages of said book to the pre-reader. Instead, the *Johnson* reference discloses a method whereby a user obtains a photograph album with a theme, the user has an outing or experience related to the theme, the user memorializes his or her outing or experience with photographs, and the user later shares the assembled photograph album with a third party. There is no planned shared experience between

the user and the third party related to the photograph album theme, and the actual shared experience between the user and the third party (reviewing the photo album) is also unrelated to the photograph album theme. Thus, *Johnson* fails to teach or suggest the claimed “planned shared experience” between a user (such as a reader) and a third party (such as a pre-reader) related to the theme of a repetitive language kit or the claimed “actual shared experience” between the user and the third party corresponding to the planned shared experience.

Neither *Panec* nor *Phillips* make up for this lack of teaching by *Johnson*. Instead, neither *Panec* nor *Phillips* teach or suggest that their methods and materials used for teaching a person to read have anything whatsoever to do with a planned shared experience between the reader and the pre-reader related to a theme of the materials, the reader sharing an actual experience with the pre-reader corresponding to the planned shared experience, or memorializing the actual shared experience between the reader and the pre-reader. Accordingly, Applicant respectfully submits that independent claims 17, 31 and 42 are patentably distinguishable over *Johnson* in view of *Panec* and/or *Phillips*. In addition, dependent claims 18, 19, 23-26, 28, 30, 33-36 and 38-41, each of which depends from and incorporates the limitations of independent claim 17 or 31, are likewise patentably distinguishable over the cited references.

In view of the foregoing amendments and remarks, Applicant submits that all of the pending claims 17-19, 23-26, 28, 30, 31, 33-36 and 38-42 are now in condition for allowance, and therefore, Applicant respectfully requests entry of the claim amendments, withdrawal of all remaining rejections, and issuance of a *Notice of Allowance*.

CONCLUSION

Entry of the foregoing amendments, consideration of the accompanying remarks, reconsideration of the application, and withdrawal of the substantive rejections is respectfully requested by Applicant. No new matter is introduced by way of the amendments. It is believed that each ground of rejection raised in the *Final Office Action* dated April 18, 2007 and in the *Advisory Action* dated July 6, 2007 has now been fully addressed.

If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Dallas, Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to contact the undersigned at the telephone number given below.

Respectfully submitted,

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